

REMARKS/ARGUMENTS

Upon acceptance and entry of this Amendment After Final Rejection, claims 17, 19, and 20 will be under active consideration in the subject patent application. Applicant requests entry of this Amendment After Final Rejection in order to place the case in better form for appeal.

In the Official Action, Examiner has:

(1) again considered the Affidavit of David Wallace under 37 CFR §1.131, filed on August 18, 2005, but found it allegedly ineffective to overcome the rejection of the proposed combination of U.S. Patent No. 5,983,198, issued to Mowery et al., and U.S. Patent No. 4,615,351, issued to Schliefer et al.;

(2) alleged that the pending claims are rejectable under 35 U.S.C. §102(b) because U.S. Patent No. 6,366,829, the patent issuing on the parent application of the instant continuation-in-part application, does not specifically disclose "automatically ordering and automatically directing a transport vehicle to deliver materials," and, therefore, cannot serve as a basis for establishing an effective priority date prior to one year after the issuance of U.S. Patent No. 5,983,198 to Mowery et al.;

(3) alleged that Applicant has in the latest Remarks attested to the invention being in public use or on sale more than one year prior to the filing of the instant application;

(4) rejected claims 17 and 20 under 35 U.S.C. §103(a) in view of the proposed combination of U.S. Patent No. 5,983,198, issued to Mowery et al., and U.S. Patent No. 4,615,351, issued to Schliefer et al.;

(5) rejected claim 18 under 35 U.S.C. §103(a) in view of the proposed combination of U.S. Patent No. 5,983,198, issued to Mowery et al., U.S. Patent No. 4,615,351, issued to Schliefer et al., and U.S. Statutory Invention Registration No. H1743, issued to Graves et al.; and

(6) rejected claim 19 under 35 U.S.C. §103(a) in view of the proposed combination of U.S. Patent No. 5,983,198, issued to Mowery et al., U.S. Patent No. 4,615,351, issued to Schliefer et al., and U.S. Statutory Invention Registration No. H1743, issued to Graves et al.

With regard to Items 1-6, and at issue in the Appeal to be filed by Applicant will be the Examiner's clear error in concluding that the Affidavit of David A. Wallace under 37 CFR §1.131, filed on August 18, 2005, is ineffective to overcome the rejections based upon proposed combinations of U.S. Patent No. 5,983,198, issued to Mowery et al. (the "Mowery reference"), and the other references cited in the Final Official Action. Notwithstanding Applicant's previous Remarks in the Preliminary Amendment to the Continuing Examination Application, the Examiner wrongly maintains that Applicant's first and only mention of automatically ordering materials and automatically directing a transport vehicle to deliver the materials is found in the engineering report dated April 13, 1998, and, therefore, the actual earliest conception of the invention did not occur prior to the effective filing date of the Mowery reference, i.e., April 23, 1996. The Examiner is ignoring the clear import of the Affidavit and the exhibits attached thereto.

The April 13, 1998 engineering report, referenced by the Examiner and attached to the Affidavit as Exhibit L, supports Applicant's statement that he was in possession of

the claimed invention prior to the effective date of the Mowery reference. The Examiner admits that the report discloses the limitations "automatically ordering materials" and "automatically directing a transport vehicle to deliver the materials." That Applicant was in possession of the invention, including these limitations, and an embodiment of the invention had already been implemented prior to the date of the engineering report is indicated by the heading "**EXISTING SYSTEM**" on page 1 of that report. Moreover, the report states in the first full paragraph of that section: "This equipment was supplied by Magyar & Associates, and installed by TriStar, Inc." Clearly, the report describes a system that had already been implemented prior to April 13, 1998.

The other exhibits attached to the Affidavit, correspondence between Applicant and various companies and individuals he consulted to reduce his invention to practice, further prove that Applicant was in possession of his invention prior to the April 13, 1998 date of the engineering report and, moreover, well prior to April 23, 1996 the effective date of the Mowery reference.

Specifically, the Affidavit includes proof that Applicant had possession of his fully conceived invention as early as February 9, 1996. Attached as Exhibit A to the Affidavit is a note from Fred Coffey of Apptech Engineered Systems providing a quote for a plumb bob unit and confirming that he would soon follow up regarding other equipment and "the method to access the inventory data from your central computer." Affidavit Exhibit B provides another note from Mr. Coffey, dated February 12, 1996, proposing the use of a "black box" at each silo group. This reference to the use of "black boxes,"

the very purpose of which is to automate processes, shows that Applicant had, by that time, already conceived of automated steps of the invention.

The Affidavit also includes evidence that Applicant continued to discuss with Apptech employees the implementation of "black boxes" to automate steps of the claimed invention after February 12, 1996. On or about March 28, 1996, Peter R. Wells, a technical representative working at the direction of Mr. Coffey, conducted a sales presentation at J.P. Donmoyer, Applicant's employer. (Affidavit ¶ 19.) Exhibit E of the Affidavit provides a letter dated April 8, 1996 making reference to that March 28 meeting. The letter indicates that at that March 28 meeting Applicant inquired about the operation of "black boxes" to call the central computer "automatically." The clear implication of this letter is that Applicant had fully conceived of the invention prior to March 28 meeting, when he asked specific questions about implementing automated steps of his invention that Mr. Wells subsequently investigated.

Ultimately, Applicant and his employer elected to work with a different engineering company, Magyar Associates, which was the company that eventually installed the first system based on the conceptions of Applicant's invention. In a sworn statement attached to the Affidavit as Exhibit F, Magyar employee Michael Karpa swears to having been approached by Applicant on May 30, 1996, to discuss implementation of Applicant's invention. Mr. Karpa states that during the week of June 3, 1996, he made a sales call at J.P. Donmoyer and during this meeting Mr. Karpa presented various equipment that could be used in implementing one embodiment of invention. Mr. Karpa specifically states that he presented "various types of leveling

systems as well as options to retrieve data from a site and transmit that data back to a central computer where the data could be displayed for the logistical purpose of consistent product replenishment in accordance with the conception of [Applicant's] invention." (Affidavit Exhibit F ¶ 3 (emphasis added).) This statement clearly indicates that Applicant was in full possession of a conception of his invention, including "automatically ordering materials and automatically directing a transport vehicle to deliver the materials," prior to June 3, 1996.

For at least these reasons, Examiner's repeated position that Applicant's actual earliest conception of the invention related to automatically ordering materials and automatically directing a transport vehicle to deliver the materials did not occur until April 13, 1998, is, in view of Applicant's August 18, 2005 Affidavit, demonstrably unsupportable and invalid.

Therefore, Applicant requests reconsideration and entry of the Affidavit under 37 CFR §1.131 submitted August 18, 2005, and the removal of the Mowery reference from consideration in the present application.

The Examiner's allegation that the pending claims are rejectable under 35 U.S.C. §102(b) because they cannot claim priority to the parent application, which has issued as U.S. Patent No. 6,366,829 ("829 Patent), is erroneous. The Examiner states that the only mention of ordering and directing in the '829 Patent are with regard to the Abstract, wherein a signal about the material quantity is automatically transmitted to a remote location. The Examiner alleges that there is no mention that the ordering of materials and/or the directing of transport vehicles occurs automatically in reference or

response to this information. There are, however, a number of references to the automated nature of Applicant's invention sufficient to sustain a claim of priority with respect to the "automatically ordering materials" and "automatically directing a transport vehicle to deliver materials" limitations.

For example, the first line of the specification of the '829 Patent states: "The invention relates to the field of automated inventory management, and in particular concerns a system for remote monitoring of material storage levels for dry bulk goods, wherein an independent entity, such as a transportation carrier, can continuously monitor raw material supply levels at a remote manufacturing plant, and, based on projected usage rates, place timely orders on behalf of the plant, with preselected vendors, to replenish depleted raw materials." (Col. 1, Ins. 6-14 (emphases added).) The clear implication of this sentence is that the invention comprises an automated system that places orders to replenish depleted materials.

The specification of the '829 Patent also states that "[i]n one aspect of the invention a remote material monitoring system is provided which can be used to monitor inventory quantities for raw materials at a remote site and automatically transmit signals corresponding to existing material levels from the remote site to a central computer at predetermined time intervals." (Col. 2, Ins. 10-15 (emphasis added).) This statement provides a clear basis of priority for claiming the automatic transmission of signals "corresponding to existing material levels," which logically includes signals sent automatically to order more materials to replenish "existing material levels" and to direct transport vehicles to deliver materials to replenish "existing material levels."

The specification also discloses that "[t]he invention concerns a Bulk Inventory Network System (BINS) used to monitor customer inventories and order delivery of dry bulk materials." (Col. 3, Ins. 25-27 (emphasis added).) In view of the disclosure at col. 1, ln. 6 that the "invention relates to the field of automated inventory management," there could be no clearer statement providing a priority basis for "automatically ordering materials."

The automatic maintenance of material levels, which logically includes the ordering and delivery of materials, is further disclosed in the statement: "For example, a manufacturer who wishes to relieve itself from the day-to-day responsibility of monitoring, recording and maintaining sufficient raw material stores can contract with a transportation carrier to provide this service." (Col. 5, Ins. 1-5 (emphasis added).)

Lastly, as part of the fully automated system described in the '829 Patent, the specification discloses that "[t]he manufacturer preselects suitable vendors for supplying each raw material. This information is provided to the transportation carrier at the time of contracting. When raw material levels fall below a predetermined acceptable level, the transportation carrier places an order with the appropriate vendor for additional material. The transportation carrier then coordinates the material shipment from the vendor to the manufacturing site using its own trucks." (Col. 5, Ins. 19-26 (emphases added).) Again, in view of the statement at col. 1, ln. 6 that the "invention relates to the field of automated inventory management," this disclosure provides a sufficient priority basis for automatically ordering and automatically directing transport vehicles to deliver materials.

In view of the above-cited quotations, Examiner's allegation that there is no basis in the parent application for a claim of priority in automatically ordering or automatically delivering materials as claimed in the instant continuation-in-part application is unsupportable and invalid. Applicant respectfully requests that Examiner reconsider and withdraw statements to this effect.

The Examiner's allegation that Applicant previously attested to the invention being in public use or on sale more than one year prior to the filing of the instant application is in clear error. The Examiner stated that after a cursory review of Applicant's statements at page 9 of the previous Remarks in the Preliminary Amendment to the Continuing Examination Application, it appeared as though Applicant asserted that the claimed invention was sold and in use on or around June 3, 1996. In the relevant portion of the Remarks, Applicant stated:

Mr. Karpa states that on the week of June 3, 1996, he made a sales call at Applicant's place of business (J.P. Donmeyer) in Ono, Pennsylvania, and stated that he was a representative of Kistler Morse, and an employee of Magyar Associates. These are the very same Magyar Associates referred to by Mr. Lowry as having installed the first system based on the conceptions of Applicant's invention related to them during this June 3, 1996 meeting. Thus, Applicant had been in full possession of a conception of his invention as of June 3, 1996. It should be noted by the Examiner that in his Affidavit, Applicant discusses the unsuitability of the Magyar installation, and Applicant's subsequent hiring of Mr. Lowry to complete the task.

(Preliminary Amendment of Aug. 18, 2005 at 9.) As is clear from the text, Applicant was describing a sales call made by Mr. Karpa of Magyar Associates at Applicant's place of business to present equipment that could be used to implement an embodiment of Applicant's invention. Although Magyar Associates eventually installed the first system

based on the conceptions of Applicant's invention as discussed at the June 3, 1996 meeting, the claimed invention was clearly not yet being publicly used or sold as a result of Magyar's efforts, if for no other reason than the fact that the Magyar implementation failed to operate! It was only through the reworking of the invention by Mr. Lowry, at the direction of Dave Wallace that an actual reduction to practice of Mr. Wallace's invention was achieved in September of 1998, when a working embodiment that was suitable for its intended purpose was completed at the Nucor facility in Darlington, South Carolina. The Examiner has simply misunderstood Applicant's statements.

Applicant respectfully requests entry of this Amendment After Final Rejection into the application so as to place claims 17, 19, and 20 in better form for appeal, or the withdrawal of the Mowery reference and the issuance of a timely Notice of Allowance.

If a telephone conference would be of assistance in advancing prosecution of the above-identified application, Applicant's undersigned Attorney invites the Examiner to telephone him at 215-979-1255.

Respectfully Submitted,

Date: 05/19/2006

/Samuel W. Apicelli/
Samuel W. Apicelli
Registration No. 36,427
Customer No. 08933
Duane Morris LLP
30 South 17th Street
Philadelphia, Pennsylvania 19103-4196
(215) 979-1255